

### **REMARKS**

Applicants appreciate the recognition of patentable subject matter in the present application. Applicants thank the Examiner for the courtesies extended to the undersigned during the telephone interview. An interview summary accompanies this response.

Claims 94-100 are added and claims 69-70 and 72-93 are pending in the present application.

Referring to the double patenting rejection, Applicants submit a copy of a terminal disclaimer previously filed in June 2004. Applicants request withdrawal of the obviousness double patenting rejection in view of the previously filed Terminal Disclaimer.

Referring to the 103 rejection of claim 69, the device recites limitations of previously pending claim 72 which was not rejected over the prior art. In addition, Applicants have amended the claim to recite transponder circuitry is coupled with the antenna and the integrated circuit is recited in a new dependent claim 95. As discussed during the interview, the inclusion of limitations of claim 72 should place claim 69 in condition for allowance in consideration of the terminal disclaimer. Applicants respectfully request allowance of claim 69 in the next Action.

The claims which depend from independent claim 69 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to the rejection of claim 83, the Examiner and the undersigned discussed the motivation to combine the reference teachings during the interview. More specifically, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed., rev. 2).

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching and the motivation **must be based on objective evidence of record**. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The Office on page 4 of the Action renders a summary and conclusory position that motivation is present for the printing of the antenna per Tuttle in Gunnarsson as a known way of providing the antenna in an efficient and economical manner (e.g., less material and less time requirements as compared to known techniques such as etching). Applicants respectfully submit the motivational rationale is not supported by objective evidence of record and is deficient to support a proper 103 rejection.

More specifically, the Office has presented absolutely no evidence that modifying Gunnarsson as alleged by the Office would provide any savings with respect to time or material as compared with the disclosure of Gunnarsson to look to Tuttle for meaningful teachings in the first instance. There is no identification of the specific teachings of Gunnarsson which would be modified to accommodate the teachings of Tuttle or that the advantages alleged by the Office would result from the combination. Gunnarsson discloses a presumptively enabled wireless transfer device which discloses the use of an antenna and ground plane. The record is void of evidence to support the conclusory statements of the Examiner that improvements would result from the combination. In addition, numerous other alternatives exist besides the positively-recited limitation of *printing the antenna*. In the absence of any motivational rationale provided by the Office, it is clear that the only motivation results from improper reliance upon Applicant's disclosure. *However, the motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination*. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Without proper objective evidence, the motivational rationale is insufficient to support a proper *prima facie* rejection and claim 83 is allowable for at least this reason.

If claim 83 is not allowed, Applicants respectfully request issuance of a non-final Action in accordance with the 37 CFR 1.104(c)(2) so Applicants may appropriately respond during the prosecution of the present application. In particular, no objective evidence of

record has been presented to support the conclusory statements made by the Office on page 4 of the Action. Further, 37 CFR 1.104(b) provides that the examiner's action will be complete as to all matters. Moreover, MPEP §706.07 (8<sup>th</sup> ed., revision no. 2) states that the examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. Without providing a non-final office action to provide Applicant with an opportunity to argue against a subsequently supported motivational rationale, Applicant would be denied a full and fair hearing and denied an opportunity to develop a clear issue with the Examiner. Accordingly, identification of a proper motivational rationale in a non-final office action is respectfully requested if claim 83 is not allowed.

The claims which depend from independent claim 83 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 88, on page 5 of the Action, it is stated that total encapsulation over the whole device housing *inherently* results in a substantially void free mass. Applicant disagrees and asserts the reliance upon inherency is misplaced. Applicant asserts that in relying upon the theory of inherency, *the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the **allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.*** *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Page 5 of the Office

states that Figs. 4A-9 allegedly illustrate the limitations of claim 88 are inherent. Applicants respectfully disagree. First, Figs. 4A-4D only illustrate details of one portion of a device as illustrated by the reference line to Fig. 4 in Fig. 3 of Tuttle. Accordingly, Figs. 4A-4D only provide further illustration of only a portion of the device and cannot be considered to disclose an entirety of the device is a substantially void-free mass as claimed. Further, Fig. 4D clearly illustrates a gap intermediate the left side of battery 40 and cover 42. The gap shows that even one portion of the device is not a substantially void-free mass. Figs. 5-9 describe intermediate processing steps to form a device and generally disclose completed devices without any teaching that the devices are substantially void-free masses as claimed. MPEP 2125 (8<sup>th</sup> ed., rev. 2) requires that drawings or pictures may be anticipatory if they **clearly show** the structure which is claimed. However, in the present drawings, gaps are present which can not be considered to clearly show the substantially void-free mass, the cross-sectional views of Figs. 4A-4D only illustrate details regarding a single portion of the device, and Applicants have failed to uncover any teachings in Tuttle of the device being a substantially void-free mass. In view of the above, Applicants respectfully request reconsideration of the rejection of claim 88 and allowance thereof in the next Action.

The claims which depend from independent claim 88 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 89 recites *grounding the conductive layer during communications of the transponder circuitry*. Grounding to ensure that undue charge has not been accumulated as a result of static charge accumulation fails to disclose communications of the transponder circuitry and fails to disclose grounding the conductive layer during communications of the transponder circuitry as recited in claim 89. Positively-recited limitations are not disclosed nor suggested by the prior art and claim 89 is allowable for at least this reason.

Applicants hereby add new claims 94-100 which are supported at least by the teachings of Figs. 5-7 and the associated specification teachings.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: \_\_\_\_\_

10/11/05

By: \_\_\_\_\_



James D. Shaurette

Reg. No. 39,833